

Serial No.: 09/690,367
Response to Office Action of 06/14/2005

Docket No. 1005.9
Customer No. 000053953

REMARKS

Applicant respectfully requests reconsideration of this application in view of the following remarks. Claims 11, 23 and 35 have been amended. Claims 8-12, 20-24 and 32-48 are pending. No new matter has been entered.

Rejection of the claims

As suggested by the Examiner, Claims 11, 23 and 35 have been amended.

The Office Action rejected claims 11, 23 and 35 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,763,496 ("Hennings").

As amended, claim 11 recites:

11. A method performed by a computer system, comprising:
 - storing a first version of a paper, the first version including a first location within the paper;
 - translating the first version into a second version of the paper, the second version being displayable on a display device as a likeness of the paper, the second version including the first location within the paper;
 - in response to content of the first version, detecting a reference within the content of the first version at the first location within the paper, the detected reference being associated with a second location; and
 - in response to the detected reference, forming a link within the second version between the first location and the second location, the link being embedded within the first location, and the first location being displayable on the display device as part of the likeness and user-selectable through the link to cause an operation associated with the second location.

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As amended, claim 23 recites:

23. A system, comprising:
a computing device for:
storing a first version of a paper, the first version including a first location within the paper;
translating the first version into a second version of the paper, the second version being displayable on a display device as a likeness of the paper, the second version including the first location within the paper;
in response to content of the first version, detecting a reference within the content of the first version at the first location within the paper, the detected reference being associated with a second location; and
in response to the detected reference, forming a link within the second version between the first location and the second location, the link being embedded within the first location, and the first location being displayable on the display device as part of the likeness and user-selectable through the link to cause an operation associated with the second location.

As amended, claim 35 recites:

35. A computer program product, comprising:
a computer program processable by a computer system for causing the computer system to:
store a first version of a paper, the first version including a first location within the paper;
translate the first version into a second version of the paper, the second version being displayable on a display device as a likeness of the paper, the second version including the first location within the paper;
in response to content of the first version, detect a reference within the content of the first version at the first location within the paper, the detected reference being associated with a second location; and
in response to the detected reference, form a link within the second version between the first location and the second location, the link being embedded within the first location, and the first location being displayable on the display device as part of the likeness and user-selectable through the link to cause an operation associated with the second location; and
an apparatus from which the computer program is accessible by the computer system.

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As stated in MPEP § 2142, "...The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness..." Also, MPEP § 2142 states: "...the examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made...The examiner must put aside knowledge of the applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed 'as a whole.'" Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. Further, MPEP § 2143.01 states: "The mere fact that references can be combined or modified does *not* render the resultant combination obvious unless the prior art also suggests the desirability of the combination."

In relation to claim 11, Hennings is defective in establishing a *prima facie* case of obviousness. As between Hennings and Applicant's specification, only Applicant's specification teaches the combination of elements in amended claim 11. In fact, Hennings teaches away from it.

For example, unlike claim 11, Hennings teach away from "the link being embedded within the first location." Instead, with reference to Fig. 9B of Hennings, the created hyperlinks 588 are embedded within respective "Elephant," "Rhino" and "Hippo" locations of the display page 584, which are different from one another, and likewise are different from the "Large Animals" location of the display page 584. Likewise, the created hyperlinks 590 are embedded within respective "Lion," "Tiger" and "Leopard" locations of the display page 584, which are different from one another, and likewise are different from the "Big Cats" location of the display page 584.

Also, unlike claim 11, the respective "Elephant," "Rhino," "Hippo," "Lion," "Tiger" and "Leopard" labels do not exist in a first version (e.g., design page 550) that is translated into a second version (e.g., display page 584). Thus, Hennings teaches away from translating a first version of a paper into a second version that is displayable on a display device as a *likeness* of the *same* paper. Further, although the "Large Animals" and "Big Cats" labels exist in both a first version (e.g., design page 550) and a second version (e.g., display page

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584), Hennings teaches away from "the link being embedded within" the "Large Animals" and "Big Cats" identifiers.

In relation to amended claim 11, the motivation for advantageously combining the claimed elements would arise solely from hindsight based on Applicant's teachings in its own specification. Accordingly, the PTO's burden of factually supporting a *prima facie* case of obviousness has not been met.

Clearly, therefore, Hennings fails to teach claim 11, and in fact teaches away from it. Thus, the motivation for advantageously combining the claimed elements would arise solely from hindsight based on Applicant's teachings in its own specification. Accordingly, the PTO has not met its burden of factually supporting a *prima facie* conclusion of obviousness in this case, and Applicant has no obligation to submit evidence of nonobviousness.

In relation to claims 23 and 35, Hennings is likewise defective in supporting a *prima facie* conclusion of obviousness.

Thus, a rejection of claims 11, 23 and 35 is not supported.

Conclusion

For these reasons, and for other reasons clearly apparent, Applicant respectfully requests allowance of claims 11, 23 and 35.

Dependent claims 8-10, 12 and 37-40 depend from and further limit claim 11 and therefore are allowable.

Dependent claims 20-22, 24 and 41-44 depend from and further limit claim 23 and therefore are allowable.

Dependent claims 32-34, 36 and 45-48 depend from and further limit claim 35 and therefore are allowable.

An early formal notice of allowance of claims 8-12, 20-24 and 32-48 is requested.

To the extent that this Response to Office Action results in additional fees, the Commissioner is authorized to charge deposit account no. 50-3524.

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Applicant has made an earnest attempt to place this case in condition for allowance. If any unresolved aspect remains, the Examiner is invited to call Applicant's attorney at the telephone number listed below.

Respectfully submitted,



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